

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-21 are presently active in this case. Claims 1-21 are amended. Support for the amendments can be found at least at page 9, lines 2-7 and page 12, lines 3-14 of the specification. No new matter has been added.

The outstanding Office Action objects the title of the invention; rejects Claims 1-2, 4-8, 10-12, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Hoffman, et al. (U.S. Patent No. 6,771,916, herein "Hoffman") in view of Okado, et al. (U.S. Patent No. 6,137,977, herein "Okado"); rejects Claims 13, 14, 16-18, and 21 under 35 U.S.C. § 103(a) as unpatentable over Moriki, et al. (U.S. Patent No. 6,077,636, herein "Moriki") in view of Hoffman and Okado; and objects to Claims 3, 9, and 15 as dependent upon a rejected base claim, but indicates that Claims 3, 9, and 15 will be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants appreciatively acknowledge the identification of the allowable subject matter.

In regard to the objection to the title of the invention, the title has been amended. Accordingly, Applicants respectfully request withdrawal of the objection.

In regard to the rejection of Claims 1-2, 4-8, 10-12, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Hoffman, Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be demonstrated. First, Hoffman in view of Okado must teach or suggest each and every element recited in the claim.¹ Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

¹ See MPEP § 2143.

of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention.² Third, a reasonable probability of success must exist with respect to the proposed combination relied upon in the rejection.³

Claim 1, as amended, recites an electrophotographic image forming apparatus comprising, *inter alia*, a developing unit configured to develop a latent image with toner, the development unit comprising a development roller configured to feed the toner to a photoconductive element to thereby produce a corresponding toner image and to collect residual toner left on the photoconductive element.

The outstanding Office Action states that Hoffman “does not disclose the developing means collecting residual means.”⁴ In other words, Hoffman does not teach or suggest a developing unit comprising a development roller configured to feed the toner to a photoconductive element to thereby produce a corresponding toner image and to collect residual toner left on the photoconductive element, as recited in Claim 1, as amended. Okado does cure the deficiencies of Hoffman in this regard. The outstanding office action cites column 30, lines 4-10 and column 32 lines 4-7 of Okado; however, the above-mentioned development roller feature of Claim 1 is not taught or suggested there. In Okado, “residual toner remaining on the photosensitive member . . . is . . . collected”⁵ However, Okado does not teach or suggest that a roller may be used both to feed the toner to a photoconductive element and to collect residual toner left on the photoconductive element. Nowhere does Okado teach or suggest a developing unit configured to develop a latent image with toner, the development unit comprising a development roller configured to feed the toner to a photoconductive element to thereby produce a corresponding toner image and to collect residual toner left on the photoconductive element, as recited in Claim 1, as amended.

² See id.

³ See id.

⁴ Office Action of August 26, 2004, page 4.

⁵ Column 32, lines 4-7 of Okado.

Accordingly, Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. § 103(a) should be withdrawn. Independent Claims 7, 19, and 20, although of different statutory class or of different scope, include recitations similar to those in Claim 1 discussed above. Claims 2, 4-6, 8, and 10-12 depend from Claim 1 or 7. For at least the reasons given above with respect to Claim 1, Applicants respectfully request that the rejection of Claims 2, 4-8, 10-12, 19, and 20 under 35 U.S.C. § 103(a) be withdrawn as well.

In regard to the rejection of Claims 13, 14, 16-18, and 21 under 35 U.S.C. § 103(a) as unpatentable over Moriki in view of Hoffman and Okado, Applicants respectfully traverse the rejection for the following reasons.

Independent Claims 13 and 21, although of different statutory class or of different scope, include recitations similar to those in Claim 1 discussed above. Accordingly, as discussed above with respect to Claim 1, Hoffman in view of Okado does not teach or suggest each and every element recited in Claim 13 or 21. For example, Hoffman in view of Okado does not teach or suggest at least a developing unit comprising a development roller configured to feed toner to a photoconductive element to thereby produce a corresponding toner image and to collect residual toner left on the photoconductive element, as recited in Claims 13 and 21, as amended. Moriki does not cure the deficiencies of Hoffman and Okado in this regard.

Accordingly, Applicants respectfully submit that the rejection of Claims 13 and 21 under 35 U.S.C. § 103(a) should be withdrawn. Claims 14 and 16-18 depend from Claim 13. For at least the reasons given above with respect to Claim 13, Applicants respectfully request that the rejection of Claims 14 and 16-18 under 35 U.S.C. § 103(a) be withdrawn as well.

Claims 3, 9, and 15 depend from Claim 1, 7, or 13. For at least the reasons given above with respect to Claims 1, 7, and 13, Applicants respectfully submit that Claims 3, 9, and 15 are in condition for allowance. Accordingly, Applicants respectfully request that the

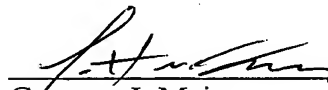
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objection to Claims 1, 7, and 13 be withdrawn and the claims be allowed.

In view of the foregoing remarks, Applicants respectfully submit that each and every one of Claims 1-21 defines patentable subject matter, and that the application is in condition for allowance. Applicants respectfully request reconsideration and reexamination of this application and timely allowance of the pending claims.

Respectfully submitted,

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